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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,710	06/15/2006	Joseph Hermes Kaal	28091/190	7920
11951	7590	02/14/2011	EXAMINER	
LeClairRyan 290 Linden Oaks Suite 310 Rochester, NY 14625			GILBERT, ANDREW M	
			ART UNIT	PAPER NUMBER
			3767	
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			02/14/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,710	<b>Applicant(s)</b> KAAL ET AL.	
	<b>Examiner</b> ANDREW M. GILBERT	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 9-16, 18-20, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 7, 9-16 and 18-20 is/are allowed.
- 6) ☒ Claim(s) 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/30/2010</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgments***

1. This office action is in response to the reply filed on 6/16/2010.
2. Claims 1-3, 7, 9-16, 18-20, 23-24 are pending for examination.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 11/30/2010 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Thorley et al (7500967).
6. Thorley et al discloses a spring retainer for a syringe (Figures) that comprises a barrel (412), a plunger (415), a spring (480) and a retractable needle (413) , said spring retainer comprising a housing having first (481) and second (418) body members adapted to releasably maintain said spring in a compressed state until rotational

Art Unit: 3767

disengagement of said first and second body members allow decompression of said spring to facilitate retraction of said retractable needle into said barrel (Summary; Figs 14a-c); wherein the second body member is adapted to be engageable by said plunger so that depression of said plunger triggers said rotational disengagement of said first body member and said second body member (Figs 14a-c). With respect to claim 23, Thorley et al discloses including a first body member (418) with projections (422a, b) that slidably engage the slots in the plunger (e.g. 416) to guide rotation of the plunger in use.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 23, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demetrio (EP 0 566 882). Demetrio discloses a spring retainer for a syringe (Figures) that comprises a barrel (2), a plunger (10), a spring (40) and a retractable needle (15), said spring retainer comprising a housing having first (21) and second (5, 6) body members adapted to releasably maintain said spring in a compressed state until rotational disengagement of said first and second body members allow decompression of said spring to facilitate retraction of said retractable needle into said barrel (Figs 6-9); wherein the second body member is adapted to be engageable by said plunger so that depression of said plunger triggers said rotational

Art Unit: 3767

disengagement of said first body member and said second body member (Figs 6-9), the the plunger having two projections (32) engagable with respective slots (33) in the first body member, the second body member having recesses (22) engagable by tabs (20) on the first body member, where disengagement of the 1<sup>st</sup> and 2<sup>nd</sup> body members is capable of allowing rotation of the bodies relative to each other (Figs 6-9). With respect to claim 23 and 24, where the 1<sup>st</sup> body member (20) has slots (33) and the plunger has projections (32).

9. However, Demetrio had projections on the plunger and slots on the 1<sup>st</sup> or 2<sup>nd</sup> body members (depending on which claims) rather than the claimed opposite. It would have been obvious to one having ordinary skill in the art at the time the invention was made to merely reverse the projections and slots on the plunger and 1st or 2nd body members because courts have held this to be an obvious design choice within the ordinary skill in the art (see MPEP (IV)(A)).

#### ***Allowable Subject Matter***

10. Claims 1-3, 7, 9-16, 18-20 are allowed.

#### ***Response to Arguments***

11. Applicant's arguments with respect to the claims have been considered but are not persuasive.

12. The applicant argues that claims 23 and 24 are allowable because they include the subject matter of allowably claim 8. This is not persuasive because claims 23 and 24 do not include subject matter present in claim 7, namely, that the depression of the

plunger *triggers* rotational disengagement of said first body member and second body member. For at least this reason, the rejection is maintained.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW M. GILBERT whose telephone number is (571)272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew M Gilbert/

Examiner, Art Unit 3767

/KEVIN C. SIRMONS/

Supervisory Patent Examiner, Art Unit 3767